

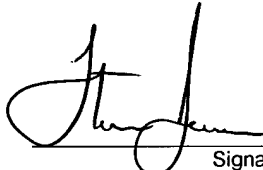
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		62898 (71589)
	Application Number	Filed
	09/733,752	December 8, 2000
	First Named Inventor Gaines W. Hammond et al.	
Art Unit	Examiner	
3738	B. E. Pellegrino	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,693</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> Signature <u>Steven M. Jensen</u> Typed or printed name <u>(617) 439-4444</u> Telephone number <u>November 28, 2005</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>		

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Dated: November 28, 2005

Signature: Michelle Chicos (Michelle Chicos)



Attorney Docket No. 62898 (71589)
[Old Docket No. BSC-181]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANTS: G. Hammond et al.

EXAMINER: B. Pellegrino

U.S. SERIAL NO.: 09/733,752

GROUP: 3738

FILED: December 8, 2000

FOR: FACILITATING DRAINAGE

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By: _____

Michelle Chicos
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REMARKS: PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks support Applicants' "Pre-Appeal Brief Request for Review" filed herewith in the above-referenced application. These remarks constitute no more than five pages, and are being filed with a Notice of Appeal, thereby satisfying the requirements.

Independent claims 10, 19, and 25 stand rejected under 35 USC §102(e) over U.S. Patent No. 5,876,417 to Devonec et al. (hereinafter "Devonec"). The remaining pending claims depend from independent claims 10, 19, and 25.

Applicants respectfully request review of the Final Office Action in the above-referenced application. No amendments are being filed with this request.

Applicants are filing the "Pre-Appeal Brief Request for Review" based on the following clear errors and/or omissions in the Final Office Action mailed on July 28, 2005.

First Clear Error and/or Omission in the Final Office Action:

The Examiner has made a clear error and/or omission at least because Devonec does not teach or suggest a proximal end of an elongated body member of a connecting segment that is releasably joined to a distal terminating end of a body member of a stent via a third member.

In the Final Office Action, it is alleged that "a connecting segment 7" depicted in FIG. 7 of Devonec is "releasably joined to the distal end of the tubular element 8 via coupling means 14" (Final Office Action at page 2). In the Advisory Action (mailed September 30, 2005), the Examiner similarly alleges "that the connecting segment [14] is 'releasably joined' to the stent [8 or 9]".

However, reference numeral 14 in Devonec corresponds to "a flexible and deformable connection means" connected to upper and lower tubular elements 8, 9 (column 4, lines 14-17). This connection means 14 is shown in, and described in relation to, FIGS. 1-10 in Devonec. The connection means 14 clearly connects the upper and lower tubular elements 8, 9 to one another. (See, for example, column 4, lines 14-23.) Also, with regard to Devonec's second embodiment shown in FIGS. 11 and 12 and described from line 54 of column 5 to line 34 of column 6, the connection means 14 clearly connects the two tubular elements 8, 9 to one another.

And, in FIG. 10 of Devonec, which relates to the positioning of both embodiments of Devonec's device in a patient (as made clear at lines 35-39 of column 6), the outer pusher tube 7

is shown detached from the lower tubular element 9, but the lower tubular element 9 always remains connected to the upper tubular element 8 via the connection means 14.

Therefore, in Devonec, the connection means 14 does not releasably join anything and instead it connects the two tubular elements 8, 9 to one another.

Second Clear Error and/or Omission in the Final Office Action:

The Examiner also has made a clear error and/or omission at least because Devonec does not teach or suggest a member comprising (i) a first portion fastened to the proximal end of the elongated body member of the connecting segment and (ii) a second portion for slip fitting into a lumen of the body member of the stent at the distal terminating end of the body member, to releasably join the connecting segment to the stent.

In the Final Office Action, the Examiner alleges that, because “the coupling member 14” of Devonec “has a smaller profile or diameter than the stent diameter tube member, it inherently must be joined by slip fitting the member into the stent body since a smaller diameter would inherently fit into the larger diameter” (Final Office Action at page 2). (See page 4 of the Final Office Action too.) Also, the Advisory Action indicates that Devonec’s “‘coupling member’ must be slip fit into the stent as claimed.”

In Devonec, the connection means 14 is nowhere described or shown as slip fitting into either of the two tubular elements 8, 9 or anything else. There is simply no disclosure of “slip fitting” in Devonec. Devonec’s connection means 14 is described as “flexible and deformable” (lines 15-16 of column 4), and it is shown krinkled or crushed upon itself in FIG. 2, but it is never shown or described in Devonec as slip fitting into anything.

In addition, the Examiner has not applied the appropriate standard for “inherency”. Inherent anticipation arises when “the prior art necessarily functions in accordance with, or

includes, the claimed limitations," regardless of whether persons of ordinary skill in the art would "recognize the inherent characteristics or functioning of the prior art." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999), citing *In re King*, 801 F.2d at 1326. Inherent anticipation with respect to "slip fitting" clearly does not arise in this instance.

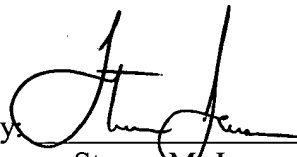
Applicants submit that all of the claims under final rejection are in condition for allowance and should be allowed and that the Final Office Action should be withdrawn.

There is no fee required for the submission of the Pre-Appeal Brief Request for Review. However, if for any reason one or more fees are required for the entry and consideration of that Request, these Remarks, or anything else being filed herewith, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,

Date: November 28, 2005

By



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